

The Examiner states that Koga discloses preparations comprising xylobiose and that Example 4 recites a composition containing xylobiose and a film forming agent. *Id.* at 2.

A rejection under §102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F. 2d 586, 587 (CCPA 1972); see also M.P.E.P. §706.02(a) ("For anticipation under 35 U.S.C. §102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.") Importantly, each and every element of a claim must be set forth in the prior art reference for there to be anticipation. See M.P.E.P. §2131.

Applicants respectfully submit that the presently claimed invention recites at least one film forming agent and at least one compound chosen from C₃-C₅ monosaccharides. Xylobiose is a **dissaccharide** not a C₃-C₅ monosaccharide. *Koga* at col 1, line 44. As a result, each and every element of claims 1-2, 10, 25, 27-30, 37-40 is not disclosed by Koga. Accordingly, Applicants respectfully request withdrawal of this rejection.

Moreover, Koga does not teach or suggest the claimed invention. For example, there is no motivation or suggestion in Koga to select at least one compound chosen from C₃-C₅ monosaccharides. To arrive at the claimed invention from Koga, one of ordinary skill in the art must pick from a myriad of possibilities without specific guidance to arrive at the claimed invention. As a result, Applicants respectfully submit that Koga's lack of specificity also does not render the presently claimed invention obvious. *In re*

Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). ("The need for specificity pervades this authority").

II. Rejections under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, there must be some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify or combine reference teachings with a reasonable expectation of success in obtaining the presently claimed invention. M.P.E.P. § 2143.01; 2143.02.

Beck

Claims 1-4, 10-40, 161, and 162 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2002/0031483 ("Beck"). *Office Action* at pp. 3-4. Applicants respectfully traverse this rejection.

The Examiner supports the rejection by noting that Beck teaches a hair treatment composition comprising sugars such as trioses, tetroses, pentoses, and film-forming cationic polymers. *Id.* at p. 3.

Applicants respectfully disagree that Beck teaches or suggests the claimed invention. For example, there is no suggestion or motivation in Beck to select at least one compound chosen from C₃-C₅ monosaccharides from Beck's laundry list of possible sugars. See *Beck* at p 1. par. [0015]. For example, in addition to trisoses, tetroses and pentoses, Beck discloses a list of C₆ sugars (e.g. glucose), disaccharides and more complex sugars such as glyceraldehydes (aldose), dihydroxyacetone (ketose),

erythrose, threose, erythrulose, ribose, arabinose, eylose, lyxose, ribulose and xylolose. Similar to Koga, to arrive at the claimed invention from Beck, one of ordinary skill in the art must pick from a myriad of possibilities without specific guidance to arrive at the claimed invention. Thus, Applicants respectfully submit that Beck's lack of specificity does not render the present claimed invention obvious. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). ("The need for specificity pervades this authority").

Applicants respectfully request that the Examiner point out the motivation provided by Beck to choose the C₃-C₅ monosaccharides of the claimed invention. Until the Examiner has met the burden of establishing a *prima facie* case of obviousness, there is no need for the Applicants to provide any proof of unobviousness.

Accordingly, Applicants respectfully request withdrawal of this rejection.

Wisotzki

Claims 1,2,5,6, 10-16, 24-40, 161, and 162 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,900,545 ("Wisotzki"). *Office Action* at pp. 4-5. Applicants respectfully traverse this rejection.

The Examiner states that Wisotzki teaches hair treatment compositions "containing panthenol, at least mono or disaccharides of pentoses or hexoses, one triol and at least one polyvinylpyrrolidone (lines bridging col.1-2)." *Id.* at p. 4. Similar to Beck, however, there is no suggestion in Wisotzki to select a C₃-C₅ monosaccharide over any other sugar disclosed such as disaccharides. To arrive at the claimed invention from Wisotzki, one of ordinary skill in the art must pick from a myriad of

possibilities without specific guidance to arrive at the claimed invention. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). ("The need for specificity pervades this authority").

Just as in Beck, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of this rejection.

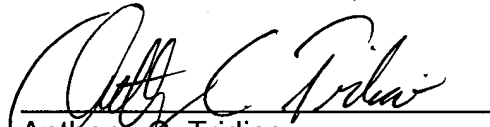
III. Conclusion

Applicants respectfully request the reconsideration and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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